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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/033,909 03/03/98 KIKUCHI

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001444 IM52/0309
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EXAMINER

COLE E

ART UNIT

PAPER NUMBER

1771

DATE MAILED:

03/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/033,909

Applicant(s)

Kikuchi

Examiner

Elizabeth M. Cole

Group Art Unit

1771



☒ Responsive to communication(s) filed on Nov 8, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 14-17, 19-21, and 23-30 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 14-17, 19-21, and 23-30 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. The request filed on 12/14/00 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/033,909 is acceptable and a CPA has been established. An action on the CPA follows.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 14-17, 19-21, 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oellerking, U.S. Patent No. 4,286,007 in view of Christensen et al, WO 97/49541.

Oellerking discloses a fabric comprising a welding portion and a fixing portion. The welding portion may be continuously formed across the perimeter of the fabric or it may be discontinuous. The welding portion comprises a weldable plastic material. The fabric may also comprise a fixing portion, (i.e., a non-coated portion). Since a fabric necessarily comprises fibers and since the weldable material comprises a thermoplastic coating on a fabric, Oellerking inherently teaches that the welding portion comprises warp fibers which are coated with a thermoplastic material.

Oellerking differs from the claimed invention because Oellerking does not specifically teach applying the welding portion so that it is the middle of the fixing portion, so that there are two fixing portions connected edge-to-edge together, so that the two welding portions are attached to the middle of said fixing portion, so that two welding portions are branched from one edge of said fixing portions. However, since Oellerking does teach that the weldable coating is applied to facilitate bonding the fabric to a substrate, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the weldable coating to the fabric in the

pattern which would have most facilitated the bonding of the fabric to a substrate. See fig. 1 and col. 2, lines 38-55; and col. 3, lines 3-15. Oellerking also differs from the claimed invention because Oellerking does not teach incorporating auxiliary fixing means into the fixing portion (i.e., the non-coated portion) of the welding fabric. Christensen teaches that providing auxiliary fixing means such as stitching in the portion of a welding fabric outside of the welded portion enhances the overall strength of the bond. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included auxiliary fixing means in the fixing portion of the welding fabric of Oellerking such as stitching the welding fabric to the substrate at a location near by outside the welded regions. One of ordinary skill in the art would have been motivated to include auxiliary fixing means by the expectation that such auxiliary fixing means would enhance the overall strength of the patch.

With regard to the limitations that the fixing portion comprises holes bored in the fixing portion and that the fixing portion comprises straps provided in the fixing portion, since Oellerking teaches that the welding fabric is suitable for use in repairing covers for containers, lorries, etc., it would have been obvious to form holes or attach straps to the fixing portion in order to enable the welded material, (i.e., the patch and the cover), to be joined or held on the materials which the welded material is covering. For example, it is known to provide holes or provide straps of fabrics which are used as tarps or covers so that the fabrics can be tied to whatever the fabric is covering. Thus, if a patch was made, (which corresponds to the welding fabric claimed), it would have been obvious to have similarly incorporated means for tying or otherwise securing the welded material to whatever the welded material was going to cover, especially if the patch were going to be welded to the fabric in an area which already comprised such holes and/or straps, since the patch would otherwise cover the holes and/or straps.

With regard to the limitation "whereby said auxiliary fixing means is used to fix the material to something other than said substrate", the limitation is a statement of the intended use of the material which does not patentably distinguish the claimed fabric.

4. Applicant's arguments filed 11/8/00 have been fully considered but they are not persuasive. In response to applicant's argument that the auxiliary fixing means is used to fix the material to something other than the substrate, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elizabeth M. Cole whose telephone number is (703) 308-0037. The examiner may be reached between 6:30 AM and 5:00 PM Monday through Thursday.

Mr. Terrel Morris, the examiner's supervisor, may be reached at (703) 308-2414.

Inquiries of a general nature may be directed to the Group Receptionist whose telephone number is (703) 308-0661.

The fax number for official faxes is (703) 872-9310. The fax number for official after final faxes is (703) 872-9311. The fax number for unofficial faxes is (703) 305-5436.



Elizabeth M. Cole
Primary Examiner
Art Unit 1771

e.m.c
March 6, 2001